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Applicants: Ryan et al.

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APPLICANT'S APPEAL BRIEF

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August 3, 2006



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PATENT TRADEMARK OFFICE

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PATENT REFERENCES

U.S. Patent No. 5,148,936 (DeGrow)	4, 7, 8, 11-15
U.S. Patent No. 6,311,860 (Reidinger et al.)	4, 7, 8, 10, 13, 15
U.S. Patent No. 6,745,505 (Moran)	4, 7, 8, 10, 11, 13-15

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I. REAL PARTY IN INTEREST

The real parties in interest in the pending patent application are the inventors Kyle A. Ryan and Suzanne L. Charnos, both of Seattle, Washington.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant or appellant's counsel that will directly affect, be directly affected by, or have a bearing in the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-15 are currently pending in the application and are at issue in this appeal.

In a final Office Action dated January 26, 2006, all of the claims were rejected under 35 U.S.C. § 103(a) in view of various combinations of prior art references.

Claims 1-8, 14, and 15 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,148,936 (DeGrow) in view of U.S. Patent No. 6,745,505 (Moran).

Claims 9-13 were finally rejected in view of DeGrow, Moran, and U.S. Patent 6,311,860 (Reidinger et al.).

IV. STATUS OF AMENDMENTS

No amendments have been filed since the Examiner's final rejection.

V. SUMMARY OF THE INVENTION

The invention is a seal for use on lids having a drink-through spout, such as are used by many coffee shops. The lid includes a plug of substantially constant cross section sized to fit

within the drink-through spout. A planar member secures to the plug and extends outwardly from the cup for easy removal. The planar member may bear graphics or text relating to a contest or other promotional activity.

Claim 1, the only independent claim, reads as follows.

1. (Previously Presented) A method for sealing a cup lid, comprising:
 - providing a beverage cup;
 - placing a lid on the cup, the lid having a planar surface formed having an aperture formed therein;
 - selecting a seal from a plurality of interchangeable seals, each of the seals having a plate with an upper surface, a lower surface, and a projection having substantially constant cross-section in a plane parallel to the plate attached to and extending away from the lower surface of the plate, the plate being sized such that at least a portion of the plate extends radially beyond a top edge of the lid when the seal is attached to the lid, the projection being configured to be insertable into the drink-through opening having the projection engaging the aperture in a friction fit to prevent liquid within the cup from leaking through the drink-through opening when the projection is inserted into the drink-through opening, and further wherein the seal is fully separated from the lid and disposable when the projection is not inserted into the opening; and
 - inserting the projection into the lid opening.

The preferred lid, cup, and seal of claim 1 are shown in Figures 1A and 1B, (reproduced at left). The beverage cups 10 of Figures 1A and 1B bears a lid 20. The planar surface bearing an aperture is shown in Figure 1A as the top of the spout 22 and in Figure 1B as a rim 27 bearing an oval-shaped opening 26. The seal is indicated by reference numbers 30, 32, and 34.

Claim 1 requires the step of “selecting a seal from a plurality of interchangeable seals.” Support in the specification for this limitation includes references to seals of a variety of colors (p. 5, ln. 6), seals bearing “trademarks, logos, or other indicia” (p. 5, ln. 9), and seals bearing a peel-off sticker used for promotional purposes (p. 5, lns. 10-11).

Claim 1 also requires that the seal include “a plate with an upper surface, a lower surface, and a projection having substantially constant cross-section in a plane parallel to the plate attached to and extending away from the lower surface of the plate.” As is apparent in Figures 1A and 1B, the seal includes a plate 32 bearing a projection 34 that is both perpendicular to the plate 30 and has a constant cross section in a plane parallel to the plate 30. The specification states that the plate 32 bears an orthogonal projection 34 having sidewalls that are “substantially parallel” to one another such that they form a cylinder in some embodiments. (p. 4, ln. 15).

Claim 1 requires that the plate be “sized such that at least a portion of the plate extends radially beyond a top edge of the lid when the seal is attached to the lid.” As shown in Figures 1A and 1B, as the seal 30 is brought downward as indicated by the arrows, a corner of the plate 32 projects outwardly from the lid 10. The specification states that the “plate 32 is preferably

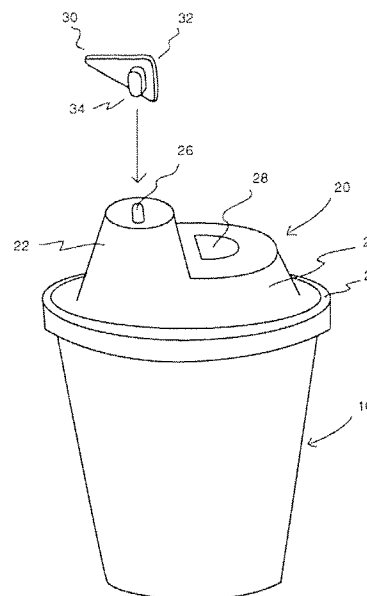


Figure 1 A

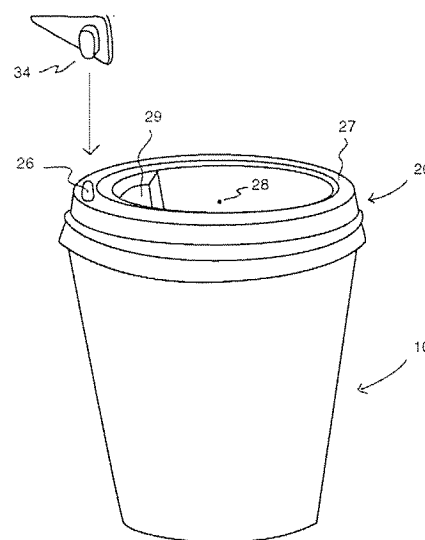


Figure 1 B

shaped to extend at least partially beyond the top edge of the spout 22 to facilitate easy removal.” (p. 4, lns. 20-21).

Claim 1 also requires that “the projection 34 [be] configured to be insertable into the drink-through opening having the projection engaging the aperture in a friction fit to prevent liquid within the cup from leaking through the drink-through opening when the projection is inserted into the drink-through opening.” With respect to this limitation, the specification states that “[t]he projection need not have any specific length, but it preferably is capable of extending through the opening 26 sufficiently far to seal the opening and to frictionally retain the seal 30 on the spout 22.” (p. 4, ln 12-14).

Finally, claim 1 requires that the seal be “fully separated from the lid and disposable when the projection is not inserted into the opening.” As is apparent in Figures 1A and 1B, the seal 30 is a separate member that is only connected to the lid 20 by the engagement of the projection 34 with the opening 26.

VI. ISSUES PRESENTED

The issue presented for review is whether the Examiner improperly rejected the pending claims under 35 U.S.C. § 103(a). In other words:

(1) Were claims 1-8, 14, and 15 improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,148,936 (DeGrow) in view of U.S. Patent No. 6,745,505 (Moran).

(2) Were claims 9-13 improperly rejected in view of DeGrow, Moran, and U.S. Patent 6,311,860 (Reidinger et al.).

VIII. ARGUMENT

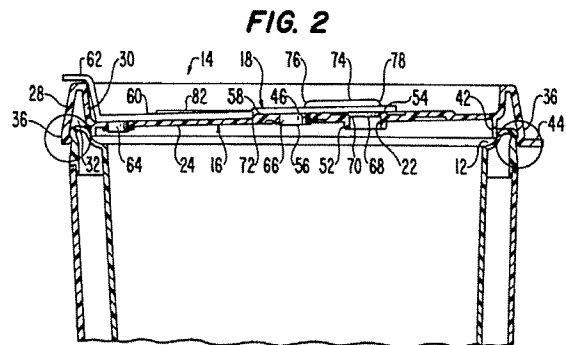
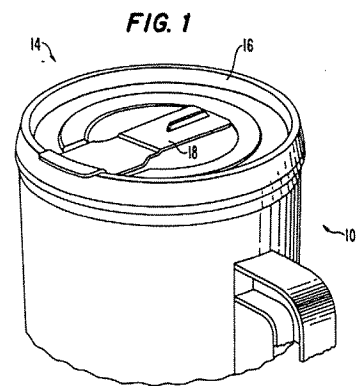
A. CLAIMS 1-8, 14, AND 15 WERE IMPROPERLY REJECTED UNDER 35 U.S.C. § 103(a)

1. *References Relied Upon For Rejection*

In the final rejection under 35 U.S.C. § 103, the Office Action rejected claims 1-8, 14, and 15 as being unpatentable over U.S. Patent No. 5,148,936 (DeGrow) in view of U.S. Patent No. 6,745,505 (Moran). The Office Action rejected claims 9-13 as being unpatentable over DeGrow in view of U.S. Patent 6,311,860 to Reidinger.

Figures 1 and 2 of DeGrow are reproduced here. The device of DeGrow is a lid for an insulated cup. The lid of the cup has a raised lip 26 surrounding a circular base 24. The circular base includes “three radially aligned through-openings,” including a “dispensing opening 20”, a “vent opening 46” and an “axle opening.” As is apparent in Figure 2, these three apertures are well below the top of the lip 26.

A stopper member 18 includes an arm 60 that extends across the three holes. An axle lug 56 secures to the arm 60 and is positioned within the axle opening. A sealing flange 64 secures to the arm 60 and fits within the dispensing opening 20. The sealing flange 64 has “tapered sides that

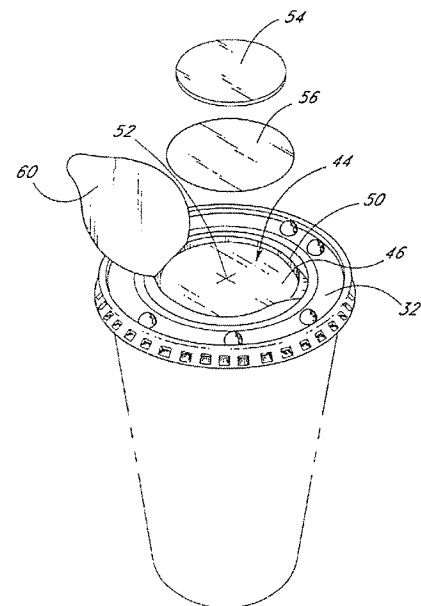
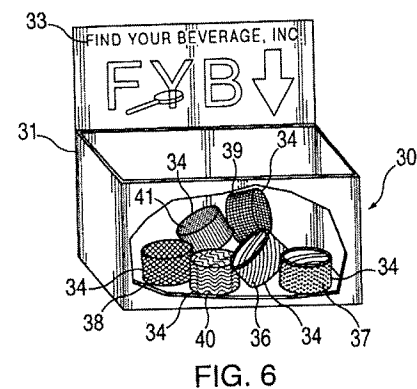


converge downwardly.” Col. 4, lns. 14-15. An annular centering boss 68 engages the vent opening 46. Col. 4, lns. 19-25.

It is readily apparent that the arm 60 has an irregular shape and is positioned well below the top of the lip 26, which forms the upper surface of the lid. The arm 60 includes a vertical offset 72 located between the axle lug 56 and sealing flange 64. A rib 74 secures to the arm 60 and serves to stiffen the arm 60. Col. 4, lns. 38-40. A handle 62 secures to the free end of the arm 60 and extends over the raised lip 26. Col. 3, lns. 61-63.

Figure 6 of Moran is reproduced to the right. Moran discloses beverage caps having multiple colors. Col. 3, lns. 28-29. The beverage caps are used by the owner of the beverage to distinguish the beverage from the beverages of others. Col. 3, ln. 63-Col. 4, ln. 5.

Figure 5 of Reidinger is reproduced below. Reidinger discloses a cup lid having a recessed well 44 formed therein for receiving a game piece 54 having a coin-like shape. Col. 4, lns. 45-47. A sealing member 60 seals the game piece 54 within the recessed well 44. Col. 5, lns. 17-20.



2. The Claims Were Improperly Rejected

Claims 1-8, 14, and 15 were improperly rejected under 35 U.S.C. § 103(a) in view of the combination of DeGrow and Moran. To establish a *prima facie* case of obviousness, the combined references must teach or suggest ***each and every claim limitation***. M.P.E.P. § 706.02(j); *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382 (“all words in a claim must be considered in judging the patentability of that claim against the prior art”). “A PTO rejection for obviousness is improper when there is nothing in the cited prior art references, either singly or in combination, to suggest the desirability of the claimed subject matter.” *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986).

In the present case, the rejection is improper, and fails to establish a *prima facie* case of obviousness, because the invention of claim 1 includes limitations neither taught nor suggested in any combination of the cited references.

a. The “plate” and “projection” of claim 1 are not found in the prior art

DeGrow fails to recite the plate and projection as recited in claim 1. Claim 1 includes the following limitations not found in the DeGrow reference.

- “a plate with an upper surface, [and] a lower surface”
- “a plate with ... a projection having substantially constant cross-section in a plane parallel to the plate attached to and extending away from the lower surface of the plate”
- “the plate being sized such that at least a portion of the plate extends radially beyond a top edge of the lid when the seal is attached to the lid”

- “the seal is fully separated from the lid and disposable when the projection is not inserted into the opening”

The arm 60 of DeGrow is not a plate. It includes a vertical step 72 a rib 74 and an upwardly extending handle 62. The plain meaning of a plate is “a smooth flat thin piece of material.” (Merriam Webster Dictionary 2006). The irregular shape of the arm 60 clearly does not meet this definition.

There is also not a portion of the arm 60 of DeGrow that may be called a plate and that both bears the projection recited in the claims and “extends radially beyond a top edge of the lid when the seal is attached to the lid.” The handle 62 of DeGrow is not a plate nor does it bear a projection. The portion of the arm 60 bearing the sealing flange 64 does not extend beyond the top edge of a lid.

DeGrow further lacks a projection having constant cross section secured to a plate. The sealing flange 64 of DeGrow has “tapered sides that converge downwardly.” Col. 4, Ins. 14-15. In a like manner, the axle lug 56 has “a slight annular enlargement or rib 66” (Col. 3, Ins. 67-68) and the annular centering boss 68 that engages the vent opening has a “generally frusto-conical sectional shape and an exterior surface 70 inclined at about 45°” (Col. 4, Ins. 22-23). The sealing flange 64, axle lug 56, and annular centering boss 68 therefore do not have a “substantially constant cross-section.”

The arm 60 of DeGrow is secured to the lid by means of the axle lug 56. Therefore, disengaging the sealing flange 64 from the lid does not cause the arm 60 to be “fully separated from the lid.”

The devices of Moran and Reidinger et al. fail to remedy the deficiencies of DeGrow. Moran discloses only twist on bottle lids. Reidinger discloses only a disposable cup lid with a game piece secured to the lid beneath a peel-away cover.

In the Office Action, the examiner did not indicate how DeGrow disclosed these claim limitations. It is clear that these elements are not found in the cited references. The rejection under §103(a) was therefore improper because the above-mentioned limitations are not taught or suggested in the prior art. *See In re Nielson*, 816 F.2d 1567 (Fed. Cir. 1987).

b. There is no suggestion or motivation to modify DeGrow to form the claimed invention

In addition, modification of DeGrow to achieve the claimed invention is not taught or suggested by the prior art. In order for an invention to be obvious, there must be a motivation in the art to modify or combine prior-art references to achieve the claimed invention. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir.), *cert. denied*, 498 U.S. 920 (1990). The need for such a motivation is particularly acute where, as here, many claim limitations are wholly missing. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Where a material element is not found in the prior art, a rejection under §103 is simply improper. *In re Fine*, 837 F.2d 1075 (Fed. Cir. 1988) (“Because neither Warnick nor Eads, alone or in combination, suggests the claimed invention, the Board erred in affirming the Examiner's conclusion that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide detector in the Eads system”).

Inasmuch as all claim limitations are not taught by the prior art, the rejection is clearly based on improper hindsight in view of the applicant's disclosure. As the Federal Circuit has cautioned, the requirement for a teaching or motivation to combine or modify is the best defense

against improper use of hindsight. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). It is impermissible to use the claimed invention as an instruction manual to piece together the teachings of the prior art to render the claimed invention obvious. *Id.* The rejection here is improper because it assumes the claimed elements are disclosed without reference to the teachings of the prior art.

The examiner further indulged in improper hindsight in combining DeGrow with Moran. The arm 60 of DeGrow is intended to remain connected to the lid when the arm 60 is moved between opened and closed positions. (“...the handle 62 on the stopper member 18 is simply lifted to flex the free end of the arm 60 upwardly away from the base 24 of the body portion 16 to thereby release the sealing flange 64 from the dispensing opening 20.” Col. 5, lns. 12-16). It is readily apparent that the arm 60, though secured by a snap-on connection by means of the axle lug 56, is intended to remain part of the lid at all times. There is therefore no suggestion to select the arm 60 “from a plurality of interchangeable seals” as recited in claim 1. The arm 60 is not a twist on lid or the like that is readily attached and detached completely such that it may function as a game piece.

With respect to claim 15, the sealing flange 64, which is the only one of the projections secured to the stop 60 having an elongate shape, is not secured to a plate nor does it have constant cross section as recited in claim 1, upon which claim 15 depends. The sealing flange 64 therefore fails to satisfy the limitations of claims 1 and 15 regarding the projection. As noted above, the sealing flange 64 of DeGrow has “tapered sides that converge downwardly.” Col. 4, lns. 14-15. As also noted above, the sealing flange 64 secures to arm 60, which has an irregular

shape that cannot be deemed a plate and which does not extend “radially beyond a top edge of the lid when the seal is attached to the lid.” Furthermore, the arm 60 of DeGrow is secured to the lid by means of the axle lug 56. Therefore, disengaging the sealing flange 64 from the lid does not cause the arm 60 to be “fully separated from the lid” as required by claim 1.

Claims 2-8, 14, and 15 depend from claim 1. For the purpose of this appeal, the applicant will rely on the arguments above with respect to claim 1, and contend only that they should not have been rejected because they depend from allowable claim 1.

B. CLAIMS 9 - 13 WERE IMPROPERLY REJECTED UNDER 35 U.S.C. § 103(a)

With respect to claim 9, there is no teaching or suggestion in the cited references to modify the stopper arm 60 of DeGrow to bear “an indicia attached to [an] upper surface” of the stopper arm 60 and “a cover removably attached to the upper surface” of the stopper arm 60 to “hide the indicia from view when the cover is attached to the plate.” As noted above, the stopper arm 60 secures to the lid of DeGrow by means of an axle lug and remains attached to the lid during use. It is not a readily removable soft-drink container lid as is the case in Moran and Reidinger. There is therefore no teaching or suggestion to form the stopper arm 60 as a game piece with a hidden indicia covered by a removable seal. Furthermore, the irregular upper surface of the stopper arm 60, including the vertical offset 72 and the rib 74, teach away from the use of a seal and indicia inasmuch as printing an indicia and securing a seal would be extremely difficult.

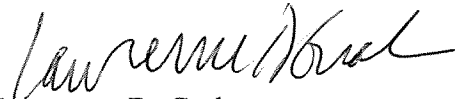
Claims 10-12 depend from claim 1. For the purpose of this appeal, the applicant will rely on the arguments above with respect to claim 1, and contend only that they should not have been rejected because they depend from allowable claim 1.

IX. CONCLUSION

For the foregoing reasons, the Examiner's final rejections should be reversed and the pending claims should be allowed.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Lawrence D. Graham", written in a cursive style.

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APPENDIX A – Claims on Appeal

1. A method for sealing a cup lid, comprising:
 - providing a beverage cup;
 - placing a lid on the cup, the lid having a planar surface formed having an aperture formed therein;
 - selecting a seal from a plurality of interchangeable seals, each of the seals having a plate with an upper surface, a lower surface, and a projection having substantially constant cross-section in a plane parallel to the plate attached to and extending away from the lower surface of the plate, the plate being sized such that at least a portion of the plate extends radially beyond a top edge of the lid when the seal is attached to the lid, the projection being configured to be insertable into the drink-through opening having the projection engaging the aperture in a friction fit to prevent liquid within the cup from leaking through the drink-through opening when the projection is inserted into the drink-through opening, and further wherein the seal is fully separated from the lid and disposable when the projection is not inserted into the opening; and
 - inserting the projection into the lid opening.
2. The method of claim 1, further comprising filling the cup with a beverage before placing the lid on the cup.
3. The method of claim 1, wherein the plurality of seals comprise a plurality of indicia, and wherein the seal is selected based on an association between the indicia and the beverage.
4. The method of claim 3, wherein at least one of the indicia comprises a logo.
5. The method of claim 3, wherein at least one of the indicia comprises a marking associated with the beverage.

6. The method of claim 3, wherein at least one of the indicia comprises a color associated with the beverage.

7. The method of claim 3, wherein the plurality of seals are formed in a plurality of different colors.

8. The method of claim 1, wherein the upper surface of the plate is triangular in shape having a corner thereof extending laterally outwardly beyond the lid in a plane parallel to the planar surface of the lid.

9. The method of claim 1, wherein the seal further comprises an indicia attached to the upper surface of the plate and a cover removably attached to the upper surface of the plate, wherein the cover hides the indicia from view when the cover is attached to the plate.

10. The method of claim 9, wherein the indicia indicates whether a consumer has won a prize.

11. The method of claim 9, wherein the indicia comprises a logo.

12. The method of claim 9, wherein the indicia comprises a coupon.

13. The method of claim 9, wherein the indicia comprises a promotional message.

14. The method of claim 1, wherein selecting the seal further comprises a consumer of the beverage selecting the seal from a container holding a plurality of seals.

15. The method of claim 1, wherein the aperture and projection have an elongate shape having their axis of elongation extending in a direction substantially tangent to a rim of the cup.